REMARKS

Responsive to the Office Action of August 27, 2003, Applicant respectfully traverses.

Claims 11-22 are currently pending. The Examiner has rejected all pending claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. § 103 as unpatentable over Chao in view of White and Brown.

I. Enablement

With due respect, the Examiner fails to make a *prima facie* case of lack of enablement by failing to construe the rejected claims and failing to provide a sufficiently reasoned basis for rejecting the claims. The Examiner rejected claims 11-20 on the grounds that the specification "fails to disclose any equations or methods to perform" the calculating step in claim 11. Without referring to any particular claim, the Examiner also appears to reject claims 11-20 on the grounds that Applicant's disclosure "fails to disclose how the liquid would be captured and placed in predetermined locations," "fails to disclose how much mass would be required to make an appreciable change in the axis of rotation," and that those failures "would require undue experimentation for one skilled in the art to carry out the claimed invention."

"Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims." MPEP § 2164.04. The Examiner has not construed any term in the pending claims.

In addition, an applicant's disclosure is presumed accurate. *In re Bowen*, 492 F.2d 859, 862-63 (C.C.P.A. 1974). When the Examiner rejects a claim for lack of enablement, "it is incumbent upon the Patent Office . . . to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *Id.* Also, "a patent need not teach, and preferably omits, what is well known in the art." *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534 (Fed. Cir. 1987).

Applicant's disclosure states that "[t]he invention may be readily understood by one of ordinary skill in the art without the benefit of a drawing." (p. 4; lns. 17-18). Applicant's disclosure also explains how a desired result from employing the present invention "can be

reasonably determined by one of ordinary skill in the art" reviewing the disclosure. (p.4; lns. 20-28). The Examiner's conclusion that Applicant's disclosure "would require undue experimentation for one skilled in the art to carry out the claimed invention" is supported only by the statements that Applicant's disclosure "fails to disclose how the liquid would be captured and placed in predetermined locations," "fails to disclose how much mass would be required to make an appreciable change in the axis of rotation." The Examiner fails to provide any evidence to demonstrate why Applicant's disclosure must provide that information before one of ordinary skill may practice the present invention without undue experimentation. Indeed, one of ordinary skill reviewing Applicant's disclosure would understand how to perform each claimed step.

The Examiner also fails to provide any support for the conclusion that Applicant's disclosure does not enable one of ordinary skill to practice the present invention without undue experimentation. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) (enumerating eight [f]actors to be considered in determining whether a disclosure would require undue experimentation"). The Examiner does not appear to consider any of the *Wands* factors.

For the above reasons, the Examiner has failed to make out a *prima facie* case of lack of enablement, and there is "no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *Bowen*, 492 F.2d at 863.

II. Obviousness

The Examiner rejected all pending claims as unpatentable over Chao in view of White and Brown. Applicant respectfully traverses, as the Examiner has fails to make a *prima facie* case of obviousness. Without a *prima facie* case of obviousness, any rejection under 35 U.S.C. § 103 is improper and should be overturned. *In re Fine*, 837 F2d 1071, 1074 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the Examiner must satisfy three basic criteria. First, the Examiner must demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings. Second, the Examiner must

show a reasonable expectation of success. Finally, the Examiner must show that the cited prior art teaches or suggests all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

The Examiner concedes that Chao fails to explicitly disclose many of the claimed steps in independent claim 11. White and Brown also fail to disclose the claimed steps. The Examiner fails to demonstrate any suggestion or motivation to modify Chao, White, or Brown to include the claimed steps. All three references identify the problem the present invention solves. As the Examiner characterizes them, White and Brown also emphasize the severity of the problem but provide no solution involving the claimed steps.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant has enclosed with this Amendment a Request for Extension of Time. Our check in the amount of $950.00 covering the fee set forth in 37 CFR 1.17(a)(3) is enclosed. Applicant believes no additional fees are due. However, if additional fees are due, please charge the deposit account of Fulbright & Jaworski L.L.P., 06-2375 under Order No. 09704227, from which the undersigned is authorized to draw.

Respectfully submitted,

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